

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 34

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte TETSUNORI SHINOZAKI,
KAZUMITSU KAWAKITA, and MAMORU KIOKA

Appeal No. 1997-3655
Application No. 08/351,136

HEARD: February 7, 2001

Before GARRIS, OWENS, and DELMENDO, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the refusal of the examiner to allow claims 48, 52 through 55 and 57 as amended subsequent to the final rejection. These are all of the claims pending in the application.

The subject matter on appeal relates to a propylene

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polymer having certain properties including a particular melt flow rate range and, for a boiled heptane-insoluble component, certain ranges of pentad isotacticity, pentad tacticity and crystallinity. Further details of this appealed subject matter are set forth in illustrative independent claim 52, a copy of which taken from the appellants' brief is appended to this decision.

No prior art has been relied upon by the examiner in the sole rejection before us on this appeal.

All of the appealed claims are rejected under the first paragraph of 35 U.S.C. § 112 for being based upon a disclosure which would not enable one skilled in the art to practice the here claimed invention. More specifically, it is the examiner's fundamental position that the scope of enablement provided by the appellants' disclosure is inadequate relative to the scope of these rejected claims. As characterized by the examiner, these claims are rejected because "they encompass to an undue extent polymers for which the specification does not enable one skilled in the art to make" (answer, page 6).

We refer to the various briefs and answers for a complete

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exposition of the opposing viewpoints expressed by the appellants and by the examiner concerning the above noted rejection.

OPINION

This rejection cannot be sustained.

It is well settled that the burden of proof lies upon the Patent and Trademark Office in calling into question enablement of an applicant's disclosure. This burden requires that the Patent and Trademark Office advance acceptable reasoning inconsistent with enablement. Upon the advancement of acceptable reasoning, the burden then shifts to the applicant to show that one of ordinary skill in the art could have practiced the claimed invention without undue experimentation. In re Strahilevitz, 668 F.2d 1229, 1232, 212 USPQ 561, 563 (CCPA 1982).

In the case at bar, it is clear that the examiner has not carried his initial burden of proof. In explaining his rationale for making the rejection before us, the examiner states that he "suspected that the claims cover structures substantially or radically different from those enabled" and

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concludes that "the facts of this case are such that if the claims in fact cover substantially or radically different structures, then these claims are broader than permitted by the first paragraph of 35 U.S.C. § 112" (second supplemental examiner's answer, page 1). Further in this regard, it is the examiner's contention that, "in a complex technology such as this when compositions are described in terms of partial structure and properties, if the claims cover compositions substantially different in structure and when appellants can, without burden, provide this information but refuse to do so, the Examiner can properly assume that the claims do cover subject matter substantially beyond the enablement" (answer, page 16).

It is apparent from the record in general and the above quotations in particular that the rejection before us is premised upon suspicions and assumptions by the examiner. However, suspicions and assumptions do not constitute acceptable reasoning inconsistent with enablement. This is particularly so in this case where these suspicions and assumptions, aside from being unsupported by probative evidence, are vague in that they relate to claim coverage of

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polymers the examiner describes with the undefined characterization of being "substantially or radically different from those enabled."

According to the examiner, his rationale in making the nonenablement rejection under consideration is supported by In re Brandstadter, 484 F.2d 1395, 179 USPQ 286 (CCPA 1973). This is incorrect. As properly indicated by the appellants, the nonenablement issue of In re Brandstadter related to all embodiments encompassed by the rejected claims and not to "suspected" embodiments which are "assumed" to be nonenabled as the examiner has done in this case.

In essence, rather than carry his initial burden of establishing a prima facie case of nonenablement, the examiner has inappropriately leaped to an unsupported conclusion of nonenablement based upon his unfounded suspicions and assumptions. In this way, the examiner inappropriately has required the appellants to carry the initial burden of proving that the here claimed subject matter is enabled. As previously indicated, it is the initial burden of the examiner to advance acceptable reasoning inconsistent with enablement. In re Strahilevitz, id. Further, the analytical framework by

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which to carry this burden is well known. See, for example, In re Wands, 858 F.2d 732, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988). The requisite analysis simply has not been performed in this case.

As a final matter, it appears to us that the examiner would limit the appealed claim coverage to polymers which are the same as those specifically disclosed in the appellants' specification or are "insubstantially" different from these specifically disclosed polymers. It has long been established, however, that to provide effective incentives, claims must adequately protect inventors. Therefore, to demand that the first to disclose shall limit his claims to what he has found will work would not serve the constitutional purpose of promoting progress in the useful arts. In re Goffe, 542 F.2d 564, 567, 191 USPQ 429, 431 (CCPA 1976).

In light of the foregoing, we cannot sustain the examiner's section 112, first paragraph, rejection of the appealed claims as being nonenabled.

The decision of the examiner is reversed.

REVERSED

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	Bradley R. Garris)	
	Administrative Patent Judge)	
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	Terry J. Owens)	BOARD OF
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	Administrative Patent Judge)	APPEALS AND
)	INTERFERENCES
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	Romulo H. Delmendo)	
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BRG:tdl

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APPENDIX

52. A propylene polymer having such properties that:

a melt flow rate (MFR) of said polymer at 230°C under a load of 2.16 kg is in the range of 0.1 to 500 g/10 min,

a pentad isotacticity M_5 obtained from the following formula (1) using absorption intensity P_{mmmm} and P_w in a ^{13}C -NMR spectrum of a boiled heptane-insoluble component contained in said polymer is in the range of 0.970 to 0.995,

a pentad tacticity M_3 obtained from the following formula (2) using absorption intensity P_{mmrm} , P_{mrmr} , P_{mrrr} , P_{rmrr} , P_{rmmr} , P_{rrrr} and P_w in a ^{13}C -NMR spectrum of a boiled heptane-insoluble component contained in said polymer is in the range of 0.0020 to 0.0050, and

a crystallinity of a boiled heptane-insoluble component contained in said polymer is 65% to about 79.3%;

$$M_5 = \frac{P_{mmmm}}{P_w} \quad (1)$$

wherein

P_{mmmm} is absorption intensity of methyl groups present in the third unit among continuous five propylene units which are bonded to each other with meso form, and

P_w is absorption intensity of all methyl groups in a propylene unit;

$$M_3 = \frac{P_{mmrm} + P_{mrmr} + P_{mrrr} + P_{rmrr} + P_{rmmr} + P_{rrrr}}{P_w} \quad (2)$$

wherein

P_{mmrm} is absorption intensity of methyl groups present in the third unit among continuous five propylene units represented by $^{\text{m}}\text{m}^{\text{m}}_{\text{k}}\text{k}$ in which m and k are each a propylene unit,

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Pmrmr is absorption intensity of methyl groups present in the third unit among continuous five propylene units represented by ${}^m{}_k{}_m$ in which m and k are each a propylene unit,

Pmrrr is absorption intensity of methyl groups present in the third unit among continuous five propylene units represented by ${}^m{}_k{}_m{}_k$ in which m and k are each a propylene unit,

Prmrr is absorption intensity of methyl groups present in the third unit among continuous five propylene units represented by ${}_k{}^m{}_m{}_k$ in which m and k are each a propylene unit,

Prmmr is absorption intensity of methyl groups present in the third unit among continuous five propylene units represented by ${}_k{}^m{}^m{}_k$ in which m and k are each a propylene unit,

Prrrr is absorption intensity of methyl groups present in the third unit among continuous five propylene units represented by ${}_k{}^m{}_k{}_m$ in which m and k are each a propylene unit.